Gp/1771

Patent
Docket No: 56208US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Gary W. Kwong, Mitchell T. Johnson, and Malcolm B. Burleigh
Serial No.: 09/728,857
Filed: 12/1/2000
Group Art Unit: 1771
Examiner: Juska, Cheryl Ann
For: WATER DISPERSIBLE FINISHING COMPOSITIONS FOR FIBROUS SUBSTRATES

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on:

October 24, 2002 — Date
Joyce M. Courtney — Signature

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Dear Sir:

This response is to the Office Action mailed September 24, 2002.

Claims 1-52 have been restricted under 35 U.S.C. § 121 as follows:

I. Claims 1-41 are said to be drawn to polyurethane finishing composition, classified in Class 524, subclass 379+;

II. Claims 42-48, 49, and 51 are said to be drawn to a method of treating a fibrous substrate, classified in Class 8, subclass 115.51+;

III. Claims 50 and 52 are said to be drawn to a treated carpet, classified in Class 428, subclass 96.

Applicant hereby confirms election of Group I (i.e., claims 1-41), with traverse, and respectfully requests reconsideration and withdrawal or modification of the restriction.

In Group I, Applicants broadly claim a finishing composition that is dispersible in water comprising a urethane.

The Restriction Requirement (Paper No. 4) in Paragraph 2 states:

Inventions of Group I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the composition could be employed in other materially different applications, such as a coating treatment for a foam or a wood substrate, rather than the presently claimed fibrous substrate.

Notwithstanding that the Group II claims may not be obvious in view of the Group I claims, and that the Group I claims may be used in a process other than that claimed in the Group II claims, Applicant submits the inventions are so interrelated that a search of one group of claims will reveal art to the other. Further, the classification of Groups I, II, and III claims in different classes and subclasses is not sufficient grounds to require restriction.

Were restriction to be effected between the claims in Groups I, II, and III, a separate examination of the claims in Groups I, II, and III would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I, II and III would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted here, because these claims of different categories are so interrelated. Further, Applicant submits that for restriction to be effected between the claims in Groups I, II, and III, it would place an undue burden on Applicant's assignee by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting three applications and maintaining three patents.

Respectfully submitted,

By _____
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